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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,316	12/08/2003	John Favuzzi	09138.0071	5097
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EXAMINER				
WRIGHT, PATRICIA KATHRYN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/731,316

Applicant(s)

FAVUZZI ET AL.

Examiner

P. Kathryn Wright

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-74, 77-79, 82, 83 and 86-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-74, 77-79, 82-83, 86-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 22, 2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 69-74, 77-79, 82-83, 86, and 88-89 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the element which rotates the slide in the slide rack from the substantially vertical disposition to a substantially horizontal disposition. Claim 69, last line, recites "said slide disposed substantially horizontally". The claim also recites a slide rack with a substantially vertically disposed slide therein and the slide remaining vertically disposed when submerged. Since the claim lacks any element to rotate the slide in the slide rack from the vertical position to a horizontal position, the claim is confusing and indefinite.

Claim 83 recites the drawer assembly comprises a plurality of said drawer assemblies, each adapted to cooperate with said fluid containment element, at least one transfer tank, a supply tank, and at least one waste tank. However, there is no antecedent basis for the transfer tank, supply tank and at least one waste tank.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 69-73, 79, 86 and 88, are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al. (US Patent no. 6,080,363), (hereinafter "Takahashi").

Takahashi teaches an automatic strainer system for staining at least one tissue sample. Specifically, Takahashi teaches system comprising:

a slide rack 14 including at least one slide having the at least one tissue sample disposed thereon (see Fig. 2);

at least one reagent (i.e., rinsing water) for application to the at least one tissue sample during a staining operation performed on the at least one tissue sample (see col. 6, lines 15-19;

at least one fluid containment element 10 or 11 (corresponds to dip tank in claim 88) with fluid (i.e., various chemical solutions) for application to the at least one tissue sample during at least one pre-treatment operation performed on the at least one tissue sample prior to the staining operation;

a slide elevator 22 for lowering the slide rack with a substantially vertically disposed slide with the at least one tissue sample and submerging the slide in the fluid containment element, the slide remaining vertically disposed in the rack 14 when submerged; and

a reagent application element 12 adapted to apply the at least one reagent (e.g., rinse water) to the at least one tissue sample with the slide (see col. 5, lines 13-15). Note that the functional recitation to the disposition of slide being substantially horizontally has not received patentable weight. Apparatus claims must be structurally distinguishable from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114.

Claims 70-73 describe the manner in which the staining apparatus is intended to be employed. Please note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed, (i.e., pre-treatment operation, target retrieval, removal of an embedding medium, etc.) fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.

As to claim 79, Takahashi inherently teaches a pneumatic element adapted to transfer liquid from a supply tank in a water supply system to a transfer tank (supply duck 16) and from the transfer tank 16 to the fluid containment element 10, 11 by and a drain element adapted to remove liquid from said fluid containment element to the

transfer tank and from said transfer tank to a waste collection tank in a drainage system (see col. 5, lines 15-30).

Regarding claim 88, the phrase "dip tank" does not include any structural limitations which would serve to distinguish from the fluid containment element 11 of Takahashi .

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 74, 78, 82-83 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (US Patent no. 6,080,363) in view of Goldbecker et al. (US Patent no. 5,601,650), (hereinafter "Goldbecker").

The teachings of Takahashi have been summarized previously above. Takahashi does not explicitly recite the use of a drawer assembly adapted to retract from the system, wherein the drawer assembly comprises the slide rack as recited in claim 74. Takahashi is does not specifically recite a fluid containment element that comprises a heating member as recited in claims 78 and 89. Nor does Takahashi teach the drawer assembly comprises a plurality of the drawer assemblies, each adapted to cooperate with the fluid containment element, at least one transfer tank, a supply tank, and at least one waste tank as recited in claim 83.

Goldbecker teaches an automatic strainer system for staining at least one tissue sample. Specifically, Goldbecker teaches a slide rack 14 including at least one slide having the at least one tissue sample disposed thereon (see Figs. 9-10);

at least one reagent for application to the at least one tissue sample during a staining operation performed on the at least one tissue sample;

at least one fluid containment element 48 with fluid (i.e., various chemical solutions) for application to the at least one tissue sample during at least one pre-treatment operation performed on the at least one tissue sample prior to the staining operation (see col. 13, lines 15-29); and

a slide elevator 124 for lowering the slide rack with a substantially vertically disposed slide with the at least one tissue sample and submerging the slide in the fluid containment element, the slide remaining vertically disposed in the rack 14 when submerged.

Goldbecker teaches a drawer assembly 44 adapted to retract from the system, wherein the drawer assembly comprises the slide rack 14 as recited in claim 74 (see col. 12, lines 27-50). Goldbecker also teaches a fluid containment element 48 that comprises a heating member 114.

Accordingly, it would have been obvious to one having ordinary skill in the art to include in the apparatus of Takahashi, the drawer assembly of Goldbecker, since the drawer assembly of Takahashi provides a means to load and access multiple slides in the system, thereby increasing analyzer throughput.

Regarding claim 83, Goldbecker teaches a single drawer assembly adapted to cooperate with the fluid containment elements. Goldbecker does not specifically teach a plurality of the drawer assemblies; however, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include in the combined system of Takahashi and Goldbecker a plurality of drawers in order increase the operator's acceptability to the slides and fluid containment elements for maintenance and/or replacement. Further, the court has held that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Note the least one transfer tank, a

supply tank, and at least one waste tank as recited in claim 83 has not been positively recited in the claim, therefore does not serve to patentably distinguish over the prior art.

Response to Arguments

10. Applicant's arguments with respect to claims 69-74, 77-79, 82-83, 86, and 88-89 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

11. Claim 77 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. No claims are allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. Kathryn Wright/
Examiner, Art Unit 1797